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Paper No. 10
HRW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Cleveland Mack Sales, Inc.

Serial No. 75/646,397

Wendy Buskop of Buskop Law Group PC for Cleveland Mack Sales, Inc.

Alex S. Keam, Trademark Examining Attorney, Law Office 114 (K. Margaret Le, Managing Attorney).

Before Hanak, Wendel and Rogers, Administrative Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

Cleveland Mack Sales, Inc. has filed an application to register the mark PERFORMANCE FINANCIAL and design, as shown below, for "financing services, namely, providing lease-purchase options in the financing of the lease or purchase of trucks, trailers, and structural parts therefor."¹

¹ Serial No. 75/646,397, filed February 23, 1999, based on an allegation of a bona fide intention to use the mark in commerce. A disclaimer of the word FINANCIAL has been made.

Registration has been finally refused under Section 2(d) of the Trademark Act on the ground of likelihood of confusion with the mark PERFORMANCE BANKING, which is registered for "banking services."²

The refusal has been appealed and applicant and the Examining Attorney have filed briefs. No oral hearing was requested.

We make our determination of likelihood of confusion on the basis of those of the *du Pont*³ factors which are relevant in view of the evidence of record. Two key considerations in any analysis are the similarity or dissimilarity of the respective marks and the similarity or dissimilarity of the goods or services with which the marks are being used. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976); *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999).

² Registration No. 1,208,978, issued September 14, 1982, Section 8 affidavit accepted. A disclaimer has been made of the word BANKING.

³ *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

Looking first to the respective marks, we are guided by the well established principle that although the marks must be considered in their entirety, there is nothing improper, under appropriate circumstances, in giving more or less weight to a particular portion of a mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Although descriptive or disclaimed matter cannot be ignored in comparing the marks, it is also a fact that consumers are more likely to rely on the non-descriptive portion of a mark as an indication of source. See *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993). In addition, it is the word portion of a mark, rather than the design features, unless particularly distinctive, that is more likely to be remembered and relied upon by purchasers in referring to the goods or services and thus it is the word portion of applicant's mark that will be accorded more weight in determining the similarity of the involved marks. See *Ceccato v. Manifattura Lane Gaetano Marzotto & Figli S.p.A.*, 32 USPQ2d 1192 (TTAB 1994).

We are in agreement with the Examining Attorney that the word portions are the most significant features of the present marks. While applicant argues that the design of a "freeway arrow" is prominent in its mark and is suggestive

of trucking and transportation, we do not find this design so distinctive as to be accorded more or even equal weight with the word portion of the mark. The words PERFORMANCE FINANCIAL remain that by which purchasers would refer to applicant's services, not the design feature. Whether purchasers would make the association between the arrow design and the fact that applicant's financing services deal with the lease or purchase of trucks appears questionable, and even if made, reliance upon the design as the source indicator would be most unlikely.

As for the word portions, we agree with the Examining Attorney that the word PERFORMANCE is the dominant or more significant portion of each mark. While, as argued by applicant, there is an obvious difference in sound of the two marks as a whole, created by the different words FINANCIAL and BANKING, these latter words are generic terms referring to the services involved and would not be relied upon by purchasers as the indication of a particular source. The word PERFORMANCE, which appears to be arbitrary with respect to these services, is the portion of each mark which would serve this purpose. As a result, the overall commercial impressions created by the marks are highly similar.

Turning to the services involved, we note that when the marks are the same or very similar, it is not necessary that the services of the applicant and registrant be similar or even competitive to support a holding of likelihood of confusion. It is sufficient if the respective services are related in some manner and/or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks used thereon, give rise to the mistaken belief that they emanate from, or are associated with, the same source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993) and the cases cited therein.

The Examining Attorney maintains that lease-purchase financing services and banking services are related services and would be offered through the same channels of trade. To support his position that there is such an interrelationship between banking services and lease-purchase financing services, the Examining Attorney relies upon several article excerpts from the NEXIS database, of which the following are representative:

The council also approved a lease-purchase agreement for a dump truck with the Bank of Illinois of Mount Vernon. *The Pantagraph* (Feb. 10, 1998);

Aldermen agreed to pay an additional \$10,200 on the 1994 truck's lease-purchase agreement with the Royal Banks of Missouri. *St. Louis Post-Dispatch* (Feb. 10, 1997);

[...] Approved an \$85,000, five-year lease purchase agreement with First Security bank for two police cars, a recreation department truck and a water utility truck. *The Deseret News* (Nov. 29, 1996);

[...] Entering into a \$121,000 lease purchase agreement with Wachovia Bank to lease three trucks ... *The Herald* (Dec. 31, 1995); and

[...] Considered a lease/purchase agreement for police cruisers and a waste truck with Fidelity Bank. *The Hartford Courant* (Aug 16, 1995).

In addition, he has made of record copies of several third-party registrations showing the registration of the same mark by a single entity for both "banking services" and lease or lease-purchase financing or, in some instances, "banking services, namely, lease or lease-purchase financing."

Applicant, on the other hand, argues that applicant's services are not those of a commercial bank, that its services have none of the accoutrements of a commercial bank, but rather applicant simply underwrites the purchase of trucks and truck parts.

We find the NEXIS evidence sufficient in itself to establish that many banks provide lease-purchase financing services. The third-party registrations made of record by the Examining Attorney provide additional evidence of the

interrelationship of the services involved herein. While these registrations are admittedly not evidence of use of the marks in commerce, they are sufficient to suggest that these services are ones which may be provided by a single entity and marketed under the same mark. See *In re Albert Trostel & Sons Co.*, *supra*; *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467 (TTAB 1988). Thus, it would be entirely plausible for persons encountering both banking and financing services in the nature of the provision of lease-purchase agreements being offered under similar marks to assume a common source therefor. Even though applicant may only provide lease-purchase financing in connection with the sale of trucks and the like, the evidence shows that this service is one which is also provided by many banking institutions.

Although applicant also argues that it is in a different channel of trade from banking institutions, no such limitation is reflected in the recitation of services. It is well settled that if there are no restrictions in the application or registration as to channels of trade, the goods or services must be assumed to travel in all the normal channels of trade for goods or services of this nature. See *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

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Here, we have no reason not to assume that registrant's banking services and applicant's financing services are being offered through the same channels of trade.

Accordingly, in view of the similar overall commercial impressions created by applicant's mark PERFORMANCE FINANCIAL and design and registrant's mark PERFORMANCE BANKING and the relationship shown to exist between lease-purchase financing and banking services, we find a likelihood of confusion.

Decision: The refusal to register under Section 2(d) is affirmed.

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